REMARKS

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 13, 18, and 29 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-34 are now pending in this application. Each of claims 1, 13, 18, and 29 are in independent form.

The Obviousness Rejections

Each of claims 1-34 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Krishnaswamy (U.S. Patent No. 5,999,525), and/or Hauser (U.S. Patent No. 6,426,957). These rejections are respectfully traversed.

None of the applied references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

Each of independent claims 1, 13, 18, and 29 recite, yet Krishnaswamy does not expressly or inherently teach or suggest, a "first common value-added service protocol adapted to communicate information regarding a value added service selected from a Policy service, a Security service, a Billing/ Accounting service, and a Visitor/Home Location service, the first common value-added service protocol adapted to communicatively interface with H.323 protocol, H.310 protocol, and H.324 protocol". In fact, neither Krishnaswamy nor Hauser mention the H.310 protocol at all.

Thus, even if there were motivation or suggestion to modify or combine the applied references (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modify the applied references (another assumption that is respectfully traversed), the applied references still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted.

It is respectfully noted that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See In re Wiechert*, 152 U.S.P.Q. 247, 251-52 (C.C.P.A. 1967) (defining "new ground of rejection" and requiring that "when a rejection is

factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

> "none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely, claims 1-34 are allowable because none of the references of record alone or in combination disclose or suggest a 'first common value-added service protocol adapted to communicate information regarding a value added service selected from a Policy service, a Security service, a Billing/ Accounting service, and a Visitor/Home Location service, the first common value-added service protocol adapted to communicatively interface with H.323 protocol, H.310 protocol, and H.324 protocol'".

PATENT

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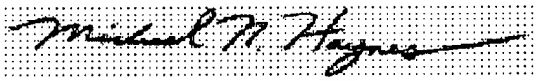
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



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